

Applicants: Wayne A. Hendrickson et al.
Serial No.: 09/609,027
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REMARKS

Claims 21, 22, 26, 27, and 48, 50, and 51 are currently pending in the subject application. Applicants have hereinabove amended claims 21, 22, 26, 48 and 50. Applicants maintain that the amendments to the claims raise no issue of new matter. Support for the amendments to claim 21 can be found in the specification as originally filed at, *inter alia*, at page 38, lines 1-12. Support for the amendments to claim 22 can be found in the specification as originally filed at, *inter alia*, at page 38, lines 26-29. Support for the amendments to claim 26 can be found in the specification as originally filed at, *inter alia*, at page 38, lines 26-29. Claim 26 has merely been amended to clarify the claim. Support for the amendments to claim 48 can be found in the specification as originally filed at, *inter alia*, page 37, lines 1-13; at page 9, lines 3-5; page 37, lines 15-17; page 10 lines 3-30; page 73, line 15; page 2, lines 7-22; page 3, lines 1-2; page 9, lines 3-4; page 8, lines 9-12; and page 10, lines 25-26. Support for the amendments to claim 50 can be found in the specification as originally filed at, *inter alia*, page 9, lines 3-4; and page 39, line 21 to page 41, line 2. Accordingly, applicants respectfully request entry of this Amendment. Upon entry of this Amendment claims 21, 22, 26, 27, 48, 50, and 51 will be pending and under examination.

Formalities

In the March 4, 2004 Advisory Action issued in connection with the above-identified application the Examiner stated that the listing of the claims in the Amendment filed January 12, 2004 does not commence on a separate sheet.

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In response, without conceding the correctness of the Examiner's position, applicants note that this Amendment is in compliance with 37 C.F.R. §1.121 as modified by 68 Fed. Reg. 38611 (June 30, 2003).

Claims Rejected Under 37 C.F.R. §112 - Second Paragraph

In the August 26, 2003 Final Office Action issued in connection with the above-identified application, the Examiner stated that claims 21-22, 26-27, 48, and 50-51 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, has possession of the claimed invention. The Examiner further stated that claim 48 is amended to recite "kit receptor" in Paper #19. The Examiner stated that the term "kit receptor" is interpreted as being the receptor to which kit binds. The Examiner stated that however, the specification only describes that SCF is the ligand that binds to its receptor, kit (see pages 2-5). The Examiner stated that it does not describe another receptor that kit binds to, and thus, this newly added claim limitation is considered a new matter. The Examiner stated that claims 21-22, 26-27, and 50-51 are rejected due to their dependency from claim 48 as thus containing the new matter.

In response, without conceding the correctness of the Examiner's position, but in order to expedite prosecution, applicants have hereinabove amended claims 48 and 50 to remove the term "Kit receptor" and replaced it with the term "Stem Cell Factor receptor". Accordingly, applicants respectfully request that the

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Examiner reconsider and withdraw this ground of rejection.

Claims Rejected Under 37 C.F.R. §103(a)

The Examiner stated that claim 48 is rejected under 35 U.S.C. §103(a) as being unpatentable over Mohammadi et al., WO 98/07835. The Examiner stated that this rejection is reiterated from the previous Office Action and maintained for reasons of record. The Examiner further stated that as set forth in the previous Office Action, Mohammadi et al. shows in the abstract and throughout its disclosure a method of performing a computer analysis using the structural coordinates of a protein kinase to identify an agent that binds to, and modulates the activity of, the protein tyrosine kinase. The Examiner also stated that the instant claims are drawn to the same method except that the coordinates of structure in the instant claims are for a different protein kinase. The Examiner stated that as set forth earlier, the coordinates are considered as non-functional descriptive material because the content of the structure coordinates of a protein or protein complex does not alter how the computational method functions, i.e., the structural coordinates of the protein does not limit the claimed method to perform different steps than the method of Mohammadi et al. The Examiner stated that therefore no patentable weight is given to the structural coordinates of the protein in the claimed method.

In response, applicants respectfully traverse the Examiner's rejection. However, in order to expedite prosecution, but without conceding the correctness of the Examiner's position, applicants have hereinabove amended claim 48. As amended, claim 48 recites preparation of a compound in step (d) which, as such, requires a non-computing method. Furthermore, this method is not

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taught by Mohammadi et al. Accordingly, the cited reference does not disclose all the elements of the claimed method.

In addition, applicants note that Mohammadi et al. discuss a method of identifying modulators based on the 3-D atomic coordinates of the protein kinase itself. In contrast, step (a) of applicants' claimed method recites computing the atomic coordinates not of the protein kinase, but of the protein kinase receptor ligand, in this case a fragment of SCF. Applicants further note that there is no teaching or suggestion in the cited reference why a computer program utilizing 3-D receptor data to identify modulators could utilize 3-D ligand data and still identify modulators. Moreover, there is no suggestion or motivation to try the claimed method, and no reasonable expectation of success.

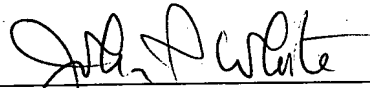
Thus, the cited reference does not support a *prima facie* case of obviousness. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

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No fee, other than the enclosed fee of \$770.00 for filing a Request for Continued Examination, is deemed necessary in connection with the filing of this Amendment. However, if any such fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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